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84-1568

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1984

No.____

QUAKER CITY GEAR WORKS, INC., *et al.*,
Petitioners,

v.

SKIL CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

1. On a motion for judgment n.o.v., to what extent, if any, should the evidence to be considered extend beyond the evidence in support of the verdict?

2. Is the rule of law against reweighing the evidence on a judgment n.o.v., as laid down in *Tennant v. Peoria & P.U.R. Co.*, 321 U.S. 29 (1944), applicable in all litigation in the federal courts including patent suits?

3. Does the law impose a more stringent standard for the granting of a judgment n.o.v. in favor of a moving party having the burden of proof as to the contested issue, than the standard otherwise applicable?

LIST OF PARTIES

Petitioners are Quaker City Gear Works, Inc. of Pennsylvania ("Quaker City") and Karlheinz Roth, a citizen of West Germany ("Roth"). The patent in suit was acquired from Roth by Quaker City and hence the actual party in interest is the latter.

Respondent is Skil Corporation of Chicago, Illinois ("Skil").

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OPINIONS BELOW

The 22 interrogatories to the jury and the responses appear in Appendix A herein, page A-1.

The Memorandum and Order of the United States District Court for the Eastern District of Pennsylvania, dated September 21, 1983, granting respondent's Motion for Judgment N.O.V., is unreported and appears in Appendix A herein, page A-8.

The Order of the United States District Court for the Eastern District of Pennsylvania dated October 25, 1983, denying the timely motion to amend the judgment rendered September 21, 1983, is unreported and appears in Appendix A herein, page A-15.

The Opinion of the United States Court of Appeals for the Federal Circuit dated November 9, 1984, affirming the District Court's holding of patent invalidity is reported at 747 F.2d 1446, and appears in Appendix A herein, page A-17.

The Order of the United States Court of Appeals for the Federal Circuit dated January 3, 1985, denying a timely filed Petition for Rehearing and Suggestion for Rehearing In Banc, is unreported and appears in Appendix A herein, page A-46.

JURISDICTION

The Judgment of the United States Court of Appeals for the Federal Circuit as to which certiorari is sought was entered on November 9, 1984 (App. A, p. A-17).

The Petition for Rehearing and Suggestion for Rehearing In Banc was timely filed on December 7, 1984, and was denied by an Order dated January 3, 1985 (App. A, p. A-46).

The instant petition is being filed within ninety days of January 3, 1985, the date of the denial of the Petition for Rehearing. The jurisdiction of this court is invoked under 28 U.S.C. §1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS AND RULES INVOLVED

Article I, Section 8, Clause 8 and Amendment VII of the United States Constitution, Title 35, U.S. Code §112 and 282, and Rules 49(a) and 50(b) of the Federal Rules of Civil Procedure are involved. These are set forth in Appendix A, pp. A-85-A-89.

STATEMENT OF THE CASE

Quaker City Gear Works, Inc. ("Quaker City") sued Skil Corporation ("Skil"), alleging that Skil willfully infringed Quaker City's gear patent No. 3,247,736 issued April 26, 1966, to Karlheinz Roth, assignor to Quaker City. Dr. Roth, a citizen of West Germany employed there as a College Professor, was joined as an additional plaintiff after Skil's motion to compel his joinder was granted.

The subject matter of the patent is a pinion-and-gear combination in which the pinion has four or fewer teeth, making possible a great speed reduction in a single stage of gearing, while retaining the gear strength required for power transmission. The suit resulted after Skil adopted a single stage speed reduction system in accordance with claims 1 and 2 of the '736 patent for many of its electric drills, relying upon a four-tooth pinion and the high gear ratio made possible. This obviated two (tandem) speed reduction gear stages, simplifying the electric drill, and made it more economical.

A separate jury trial was held on the issue of liability. It concluded in the submission to the jury of a series of 22 interrogatories. The overall effect of the jury's answers was summarized by the District Court thus:

> ". . . when one reviews the jury's answers to the twenty-two interrogatories as a whole, they are sufficiently consistent to indicate the jury's intent to return a verdict for the plaintiffs. . . ." (App. A, p. A-11)

Among these interrogatories propounded to the jury were several interrogatories listing various prior patents and publications, and asking the jury whether the patented invention would have been obvious in view thereof — interrogatories which the jury answered in the negative. (App. A, pp. A-3 and A-4). Also included were Interrogatories 20, 21 and 22 concerning infringement and willfulness, in response to which the jury gave affirmative answers, that the Skil drills (typified by Model 560) use gearing which infringes the Roth patent, and that the infringement by Skil Corporation is willful (App. A, p. A-7).

Interrogatory No. 11, which relates to and takes wording from the first paragraph of 35 U.S. Code §112 (App. A, p. A-4) is copied below:

Interrogatory #11

> Does the specification of the Roth patent, that is, the portion of the patent in Columns 1, 2, 3, 4 and the first four lines of Column 5, contain a written description, including its drawings and text, of the alleged invention in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same?

The jury's answer to this Interrogatory No. 11 was: YES. (App. A, p. A-4).

Following the special verdict expressed through the jury's answers to interrogatories, defendant brought a motion for judgment n.o.v., or for a new trial, *inter alia*. Among the many grounds urged was defendant Skil's contention that the Court should award judgment to it on the ground that the '736 patent is invalid under the first paragraph of 35 U.S. Code §112. Skil contended that the reason the specification of the '736 patent does not suffice to enable persons skilled in the art to make and use the invention is because of dependency upon a

foreign publication mentioned in certain places in the patent, namely, a German Industrial Standards publication referred to as "DIN 58400."

On September 21, 1983, the District Court issued its Memorandum and Judgment Order in favor of defendant (App. A, pp. A-8 to A-14). It rejected several of defendant's contentions, but ruled in favor of defendant on its contention that the German Industrial standard 58400 was "essential material" to supplement or augment the disclosure of the '736 patent to enable persons skilled in the art to make and use the invention, wherefore the District Court, by judgment n.o.v., held that the specification of said United States patent does not ". . . contain a written description . . . of the alleged invention in such full, clear, concise and exact terms as to enable any person skilled in the art . . . to make and use the same," notwithstanding the jury's affirmative answer to Interrogatory No. 11. (App. A, pp. A-9 and A-10). It therefore held the patent invalid and granted judgment n.o.v.

The District Court's erroneous view was:

> "No interrogatory was requested or submitted to the jury concerning whether the German Standard was essential material. Accordingly, under Fed. R. Civ. P. 49(a) the court may make this finding of fact. . . ." (App. A, pp. A-9 & A-10, emphasis added)

Petitioners appealed. The Court of Appeals for the Federal Circuit held that a finding of fact that the German document was not essential was "an implicit and inherent finding of the jury within a broader question," and hence, "the court had to accept the jury's determination and could set it aside only if it were not supported by substantial evidence." (App. A, pp. A-28 & A-29). Accordingly, it held that the District Court was incorrect as a matter of law in deeming itself free to make an initial fact finding as to essentiality.

However, the Court of Appeals for the Federal Circuit neither reversed nor remanded the case. Instead, it reweighed the evidence on both sides of the question of essentiality, without benefit of observing the witnesses, and relying on inferences of its choice and on its interpretation of excerpts of attorney correspondence, to reach its own finding of fact opposite to the jury's, that the U.S. patent had a fatal deficiency of disclosure without the German publication, making that document essential. That resulted in an affirmance of the District Court's *result*, i.e. judgment of dismissal. (App. A, pp. A-29 to A-33).

This patent infringement litigation presents questions as to the law's restrictions on the power of an appellate court to reweigh conflicting evidence and grant judgment notwithstanding the verdict on a matter which a jury resolved in reaching its special verdict. It raises the need for the Supreme Court to express itself as to the limitations upon a court's power to substitute its weighing of the evidence for that of a jury on a disputed factual issue. Urgency of this need for judicial guidance results from the pronounced tendency of the recently established Court of Appeals for the Federal Circuit to develop, and then to be guided mainly by, its own body of precedential law. (Infra, p. 6, n. 1).

REASONS FOR GRANTING THE WRIT

The Need For Resolution Of The Question As To The Evidence To Be Considered On A Motion for Judgment N.O.V.

In laying the groundwork to reweigh the evidence, the Court of Appeals for the Federal Circuit rejected the view that it is to "look only to evidence in [plaintiff Quaker City's] favor to determine whether 'substantial evidence' supports the implicit factual finding that the German Standard was not 'essential material'," stating

"[t]he law is clearly to the contrary." (App. A, p. A-31). It cited a prior decision of the same court for the proposition that "a court must *consider all the evidence* (emphasis the Court's) (App. A, p. A-31).[1] The Court of Appeals cited testimony of Berlinger and Drago which stands in support of this factual finding by the jury, without finding any fault. (App. A, pp. A-29 & A-30). It then launched into an extended evaluation of several portions of the evidence adduced by defendant Skil, including, *inter alia*, Roth's testimony about his German application and the German standards paper. The Court deemed these, considered together, sufficient to convince it that Skil should prevail on the ground of unavailability of a German standards publication of a certain "draft," that document being adjudged by it, as opposed to the jury's finding, to be "essential material" to Roth's U.S. patent. The Court did not explain how it could reach this conclusion without taking into account the very extensive differences between the earlier German application and the U.S. patent (with its far more complete description).[2] In any event, this reweighing of the evidence was not in accordance with the law.

In *Wilkerson v. McCarthy*, 336 U.S. 53, 57, 69 S. Ct. 413, 415 (1949), the Supreme Court said:

> "It is the established rule that in passing upon whether there is sufficient evidence to submit an is-

1. Most of the precedents cited are earlier decisions of the same Court, handed down since late 1982 (App. A pp. A-17 to A-35). In its first appeal to be heard, *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982), said Court sat in banc expressly "to consider what case law, if any, may appropriately serve as established precedent." Its resolution of this question was: "We hold that the holdings of our predecessor courts, the United States Court of Claims and the United States Court of Customs and Patent Appeals, announced before the close of business September 30, 1982, shall be binding as precedent in this court."

2. The substantial additional material in the patent is shown in the side-by-side comparison of the German application and the U.S. patent in App. B, pp. B-9-B-18.

> sue to the jury we need look only to the evidence and reasonable inferences which tend to support the case of a litigant against whom a peremptory instruction has been given."

The *Wilkerson* case was an FELA case. Some writers have questioned whether the Supreme Court intended this rule to apply broadly to all litigation, or intended it to be applicable only to FELA and Jones Act cases. Among the comments on this rule are those offered by Wright and Miller, Federal Practice and Procedure, Vol. 9, §2529, pp. 572-573. Said authors advocate a rule "that the Court may consider all of the evidence favorable to the position of the party opposing the motion as well as any unfavorable evidence that the jury is *required* to believe." (id., at 573). The authors add, "*[b]ut statements that all of the evidence is to be considered are too broad.*" (id., emphasis added).

It would be a significant service to the bench and bar for the Supreme Court to express itself on this point, not only to promote uniformity of action on motions for directed verdicts and for judgments n.o.v. among all the Courts of Appeals, but also, to provide reassurance that in cases involving patents, the same principles and rules of law governing jury trials apply which are recognized and relied on in the other segments of the law.

In a dissent to denial of *certiorari* in *Schwimmer v. Sony Corp. of America*, 103 S. Ct. 362 (1982), the view was expressed that it would be beneficial to resolve the differences among the circuits "concerning the portion of the evidence a court is to consider in ruling upon a motion for judgment notwithstanding the verdict." (103 S. Ct. at 363). As the dissenting Justice observed, "[b]ecause the scope of review will often be influential, if not dispositive, of a motion for judgment n.o.v., this disagreement among the federal courts of appeals is of far more than academic interest." (103 S. Ct. at 364).

In the present case, the Court of Appeals for the Federal Circuit deemed the scope of review to be crucial, and looked back only as far as an earlier case of the same court, and an inapposite case decided by this Court in 1951.[3] Had there been a prior resolution of the conflicts as to scope of review, it could well have been dispositive here with an opposite result.

The Reweighing of the Evidence by The Court of Appeals For The Federal Circuit Was In Contravention of Established Law

When defendant Skil moved for a directed verdict of invalidity on the ground that a German publication (a DIN 58400 Industrial Standards publication) was "essential material" necessary to be considered along with the United States patent in suit in order for it to provide an enabling disclosure, the District Court, after extensive discussion of that motion, denied it (Appendix A, pp. A-73 to A-76), ruling that the matter must proceed to the jury. This action by the District Court was proper, because there was conflicting testimony and there were conflicting inferences to be drawn and conclusions to be reached.

After receiving the jury's special verdict, holding in favor of the plaintiff, the District Court once again had the question whether a DIN 58400 German paper was "essential material" raised by defendant Skil's motion for judgment n.o.v.

Erroneously believing itself free to do so under Fed. R. Civ. P. 49(a), the District Court proceeded to weigh the evidence and pass judgment that a DIN 58400 paper was essential — that without it, the U.S. patent fails to

3. *Universal Camera Corp. v. National Labor Relations Board*, 340 U.S. 474, 71 S. Ct. 456 (1951), was cited for comparison to the holding that *all* the evidence is to be considered. That case did not involve a jury verdict. Instead, it involved review by Courts of Appeals of orders of the National Labor Relations Board, in compliance with the Wagner Act.

provide such disclosure of the invention as to enable anyone skilled in the pertinent art to make and use the invention. A preponderance of the evidence as viewed by the District Court would suffice according to its erroneous theory, said Court's appraisals of credibility and assignments of weight being taken into account.

When the Court of Appeals for the Federal Circuit ruled that Fed. R. Civ. P. 49(a) does not apply here since the jury had made the inherent finding that the German paper is not essential, this should have resulted in a reversal of the District Court's judgment n.o.v., since the evidence before the jury involved evidence on both sides of the question of sufficiency of the disclosure of the United States patent to enable those skilled in the art to make and use the invention. This fact was acknowledged to the jury by defendant Skil. Skil reminded the jury of the testimony of Bobel and Thoen, urging the jury to find believable their testimony critical of the patent, but acknowledged that their testimony was opposed to the testimony of Drago and Berlinger, leaving the jury to determine which it found more persuasive (App. A, A-79 to A-81). Skil also included its contention that Professor Roth had made an admission about a German publication being necessary, and urged the jury to conclude that in the absence of such publication, the patent could not provide the required *enabling* disclosure. As Skil acknowledged to the jury concerning Interrogatory 11, "*you've got conflicting tesimony.*" (App. A, p. A-80).[4]

Since it is indisputable that the jury was confronted with and had to resolve conflicting testimony, weighing all the evidence as to enabling disclosure in reaching its finding as set forth in answer to Interrogatory No. 11 and

4. The District Court also charged the jury to much the same effect in regard to Interrogatory 11, thus: "You've heard a lot of evidence in this case, and once again I will not repeat it or make reference to who called the various witnesses, but there has been a lot — a lot of evidence as to this particular issue and it's for your determination." (App. A, p. A-81).

its overall special verdict in favor of plaintiff, and since the specific question of "essential material" *had indeed* been considered by the jury and resolved in favor of petitioners, the Court of Appeals for the Federal Circuit was not free to reweigh the evidence and redecide the question of essentiality of the German paper for an enabling disclosure of the *United States patent*, overturning the jury's finding. *Continental Ore Co. v. Union Carbide and Carbon Corp.*, 370 U.S. 690, 696-97 and 700-701, 82 S. Ct. 1404, 1409 and 1411 (1962), *Tennant v. Peoria & P.U.R. Co.*, 321 U.S. 29, 35, 64 S. Ct. 409, 412 (1944). See U.S. Constitution Amendment VII (App. A, p. A-89).

In the *Tennant* case, in reversing a judgment *n.o.v.* below, the Supreme Court stated the law as follows:

> It is the jury, not the court, which is the fact-finding body. It weighs the contradictory evidence and inferences, judges the credibility of witnesses, receives expert instructions, and draws the ultimate conclusion as to the facts. The very essence of its function is to select from among conflicting inferences and conclusions that which it considers most reasonable. That conclusion, whether it relates to negligence, causation, or any other factual matter, cannot be ignored. *Courts are not free to reweigh the evidence and set aside the jury verdict* merely because the jury could have drawn different inferences or conclusions *or because judges feel that other results are more reasonable.*
> [citations omitted]
>
> (321 U.S. at 35, emphasis added).

In the *Continental Ore* case, the Supreme Court, citing *Tennant*, observed,

> Undoubtedly, all of the evidence during this period does not point in one direction and different inferences might reasonably be drawn from it. There was, however, sufficient evidence to go to the jury

and it is the jury which "weighs the contradictory evidence and inferences" and draws "the ultimate conclusion as to the facts."

The fact that the Court of Appeals for the Federal Circuit indulged in reweighing the evidence is borne out by the several items of evidence it selected and relied on as tending to support the non-enabling disclosure result it reached (opposite to that of the jury). (App. A, pp. A-32 to A-33). Its failure to reach the same result as the jury's may well have resulted from the Court of Appeals seemingly having totally disregarded the great differences between Professor Roth's quite self-sufficient U.S. patent and his German application — the only one as to which he was asked about referring to DIN 58400.

In Weighing the Evidence, the Court of Appeals for the Federal Circuit Casts Aside The Rule of Law That The Direction of the Burden of Proof is Significant

The opinion of the Court of Appeals for the Federal Circuit demonstrates obliviousness to the principle of law that an especially high standard is to apply where the burden of proof as to the matter in issue is on the party moving for a directed verdict or for judgment *n.o.v.*

That rule is quite generally applied by the textbooks, the U.S. Courts of Appeals and District Courts, and various state courts.[5] Among the U.S. Court of Appeals cases on this rule of law are:

Allen v. Zurich Ins. Co., 667 F.2d 1162, 1164-65 (4th Cir. 1982)

Mihalchak v. American Dredging Co., 266 F.2d 875, 877 (3rd Cir.), *cert. denied* 361 U.S. 901 (1959)

Fireman's Fund Ins. Co. v. Videfreeze Corp., 540

5. See for example 88 CJS Trials §257, pp. 667-71. See also Wright & Miller, Federal Practice and Procedure, Vol. 9, §2535, pp. 592-93.

F.2d 1171, 1177 (3rd Cir. 1976), *cert. denied* 429 U.S. 1053 (1977)
Service Auto Supply Co. of P.R. v. Harte & Co., 533 F.2d 23, 25 (1st Cir. 1976)
Powers v. Continental Casualty Co., 301 F.2d 386, 388 (8th Cir. 1962)
Hurd v. American Hoist & Derrick Co., 734 F.2d 495, 498-99 (10th Cir. 1984)

So far as petitioner can determine, the Supreme Court has not expressed disapproval or approval of the principle for which these cases stand.

Allen v. Zurich Ins. Co. has much in common with the present case. After plaintiff Allen obtained a jury verdict, the defendant successfully moved for judgment n.o.v. Upon Allen's appeal, the Court of Appeals overturned the District Court's granting of judgment n.o.v. to Zurich Insurance Co. on an affirmative defense, stating:

> Applying that [stringent] standard to the evidence in this case, we do not think it was appropriate to grant judgment n.o.v. for Zurich on this basis. The dispositive issue was whether at the critical time Allen was Scruggs' employee acting in the course and scope of his employment. . . ."
>
> (667 F.2d at 1165)

The court in that cited case recognized that "the evidence was in substantial conflict," and that the method of payment and right to fire could "lead to conflicting inferences." (id.). As the court observed,

> We must bear in mind the critical point that here the burden of persuasion was not upon Allen to establish that he was not Scruggs' employee, but upon Zurich to establish that he was. To hold that Zurich was entitled to judgment as a matter of law we must find that not only was there sufficient evidence, so manifestly credible that it must be believed, to sup-

> port a finding that Allen was Scruggs' employee, but also that there was insufficient evidence from which the jury could rationally have made any other finding. [citation omitted] This we cannot do, and we therefore conclude that the district court erred in granting judgment n.o.v. on this basis.
>
> (667 F.2d at 1165)[6]

In the present case, the defendant Skil had the burden of persuasion that the Roth U.S. patent was fatally deficient in its disclosure, [i.e., that it did not suffice to enable persons skilled in the art to make and use the invention]. This parallels the cited case wherein the defendant Zurich had the burden of persuasion that the plaintiff Allen was an employee of Scruggs. Thus, unless and until this Court should announce a turning away from all the foregoing authorities, the Court of Appeals for the Federal Circuit should be led to come into conformity with the several other circuits, the text writers, and the cases in numerous state courts, to recognize that judgment n.o.v. should not be freely granted to the party having the burden of persuasion as to the issue to which its motion for judgment n.o.v. is directed.

Under 35 U.S. Code §282 (App. A, p. A-86), "A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." Among the invalidity defenses to be alleged and proven by an accused infringer-defendant under this section is "(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title." (App. A, p. A-86.)

Since defendant Skil alleged invalidity of the Roth U.S. patent for failure to meet the enabling disclosure

6. The Court of Appeals for the Fourth Circuit ultimately held for the defendant-appellee Zurich on different grounds, i.e., on judicial estoppel, in view of certain inconsistencies in Allen's main representations.

requirement of Section 112 of Title 35 (App. A, p. A-85). Section 282 placed upon Skil the burden of establishing invalidity on that ground. Therefore, the rule of law of the above-cited cases and texts applies.

The Court of Appeals for the Federal Circuit, whether or not with full awareness of the impact, has substituted its own opposite finding of fact for that of the jury, in disregard of, or in derogation of, the law on the significance of the burden of proof.

Unless the law of *Allen v. Zurich Ins. Co.* and the numerous other above-cited cases is to be overturned, the Court of Appeals for the Federal Circuit should have been required to conform. It should have faced up to the requirement (paraphrasing the *Allen* case) that it "find that not only was there sufficient evidence, so manifestly credible that it must be believed, to support a finding that [a German paper was essential for enabling disclosure in the U.S. patent in suit], but also that there was insufficient evidence from which the jury could rationally have made any other finding." Here, as in the cited case, the Court could not have metthat requirement. Upon respecting the established law, it would have had to reverse the judgment n.o.v.

A pronouncement on this rule of law by the Supreme Court should put this matter to rest and provide valued guidance for the bench and bar.

CONCLUSION

For all of the above reasons, we respectfully suggest that certiorari be granted, that the judgment of the Court of Appeals be reversed, and that the case be remanded for the further proceedings consistent with the jury's verdict.

Respectfully submitted,

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